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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/683,783

02/13/2002

Kevin Carl Archibald

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9498

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

07/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/683,783

Applicant(s)

ARCHIBALD ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 3 April 2007. Claims 1, 5, 7-9, 13, 15-17, 21, 23-24 have been amended. Claims 1-24 remain pending..

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Newly amended claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Claims 7, 15, and 23 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- "third response" as disclosed in claims 7 15, and 23 at lines 5, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

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a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 13 February 2002. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 13 February 2002.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-2, 9-10, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Malley et al, U.S. Patent Application Publication Number 2002/0026408 and Quido, et al., U.S. Patent Application Publication Number 2003/0093302, for substantially the same reasons given in the previous Office Action (paper number 20070207). Further reasons appear hereinbelow.

(A) Claims 1, 9 and 17 have been amended to include the recitation of

- ♦ "the customer first response comprising a message to a manufacturer," in lines 7-8, 9-10, and 9-10, respectively;
- ♦ "adjusting the budgetary quote based on the customer first response," in lines 9, 11, and 11, respectively; and
- ♦ "receiving a customer second response comprising a request for a contractual quote," in lines 10-11, 12-13, and 12-13, respectively.

As per amended claims 1, 9 and 17, O'Malley and Quido teach a network based method, system and computer readable medium for facilitating providing a customer with a quote for at least one of a manufactured product and a service as analyzed and discussed in the previous Office Action (paper number 20070207), the method comprising:

the customer first response comprising a message to a manufacturer (O'Malley; paragraphs [0003], [0018], [0028]);

modifying (reads on "adjusting") the budgetary quote based on the customer first response (Quido; paragraph [0042]); Examiner interprets Quido's teachings of "[o]nce a quote has been processed and a premium has been generated, the customer would be able to modify

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any quote information ... [...] ... during the quoting process rather than in the binding process” to teach a form of “adjusting the budgetary quote” and

receiving a customer second response comprising a request for a contractual quote (Quido; paragraph [0018]).

The remainder of claims 1, 9, and 17 is rejected for the same reasons given in the prior Office Action (paper 20070207, section 4, pages 2-5), and incorporated herein.

The motivations for combining the respective teachings of O’Malley and Quido are as given in the rejection of claim 1 in the prior Office Action (paper 20070207), and incorporated herein.

(B) Claims 2, 10, and 18 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20070207, section 4, pages 4-5), and incorporated herein.

7. Claims 3, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over O’Malley et al, U.S. Patent Application Publication Number 2002/0026408 and Quido, et al., U.S. Patent Application Publication Number 2003/0093302, as applied to claims 1, 9, and 17 above, and further in view of Singh, U.S. Patent Application Publication Number 2001/0047311, for substantially the same reasons given in the previous Office Action (paper number 20070207). Further reasons appear hereinbelow.

(A) Claims 3, 11 and 19 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20070207, section 5, pages 5-7), and incorporated herein.

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8. Claims 4-8, 12-16, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Malley et al, U.S. Patent Application Publication Number 2002/0026408 and Quido, et al., U.S. Patent Application Publication Number 2003/0093302, as applied to claims 1, 9, and 17 above, and further in view of Duke, International Publication Number WO 01/37177 A1 for substantially the same reasons given in the previous Office Action (paper number 20070207). Further reasons appear hereinbelow.

(A) Claims 8, 16, 24 have been amended to include the recitation of

- ♦ "the customer first response comprising a message to a manufacturer," in lines 13-14, 15-16, and 14-15, respectively;
- ♦ "adjusting the budgetary quote based on the customer first response," in lines 15, 17, and 16, respectively; and
- ♦ "receiving a customer second response comprising a request for a contractual quote," in lines 16-17, 18-19, and 17-18, respectively.

As per amended claims 8, 16, 24, O'Malley, Quido and Duke teach a network based method, system and computer readable medium as analyzed and discussed in the previous Office Action (paper number 20070207), the method comprising:

the customer first response comprising a message to a manufacturer (O'Malley; paragraphs [0003], [0018], [0028]);

modifying (reads on "adjusting") the budgetary quote based on the customer first response (Quido; paragraph [0042]); Examiner interprets Quido's teachings of "[o]nce a quote has been processed and a premium has been generated, the customer would be able to modify

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any quote information ... [...] ... during the quoting process rather than in the binding process”
to teach a form of “adjusting the budgetary quote” and

receiving a customer second response comprising a request for a contractual quote
(Quido; paragraph [0018]).

The remainder of claims 8, 16, 24 is rejected for the same reasons given in the prior
Office Action (paper 20070207, section 6, pages 7-12), and incorporated herein.

The motivations for combining the respective teachings of O'Malley, Quido and Duke
are as given in the rejection of claim 8 in the prior Office Action (paper 20070207), and
incorporated herein.

(B) As per the amendments to claims 5, 7, 13, 15, 21, 23 these appear to have been
made merely to correct minor typographical or grammatical errors in the claim language or to
change dependencies. While these changes render the language of the claim smoother and more
consistent, they otherwise affect neither the scope and breadth of the claim as originally
presented nor the manner in which the claim was interpreted by the Examiner when applying
prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the
prior Office Action (paper number 20070207, section 6, pages 7-12), incorporated herein.

(C) Claims 4, 6 12, 14, 20 and 22 have not been amended and are rejected for the
same reasons given in the previous Office Action (paper number 20070207, section 6, pages 7-
12), and incorporated herein.

Response to Arguments

9. Applicant's arguments filed 3 April 2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 3 April 2007.

(A) At pages 12-24 of the 3 April 2007 response, Applicant argues that the claim limitations in claims 1-24 are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references have been fully addressed by the Examiner as being or obvious in view of the collective teachings of the cited references, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20070207), and incorporated herein. In particular, Examiner notes that the limitations of the customer first response comprising a message to a manufacturer and adjusting the budgetary quote based on the customer first response and receiving a customer second response comprising a request for a contractual quote are taught by the combination of the applied references (see O'Malley; paragraphs [0003], [0018], [0028]-[0029]) and (Quido; paragraphs [0018], [0042]). In particular, Examiner interprets O'Malley's teachings of "[u]ser 109 is typically a customer desiring to purchase and/or sell a product, service or other item of commerce from a supplier ... [...] ... User 109 may alternatively be a merchant, a distributor, a supplier, a person, an entity, software, hardware and/or the like desiring to transact or otherwise communicate with a customer, a supplier, a distributor, and/or a manufacturer. In this manner, user 109 may transact or otherwise

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communicate in a business to business environment, a business to customer environment, and/or a customer to customer environment depending on the context of the transaction. User 109 may interact with the various elements of system” (O’Malley; paragraph [0018]) and O’Malley’s teachings of “[a] quote may include a bid on a product or service, information on a product or service, and/or the like. A quote may be in relation to any product or service that user 109 may have an interest in or is offering for sale, and may further be based on information on user 109 (e.g., profiling information on user 109). The supplier may be a seller, a merchant, an RFQ provider, a manufacturer, and/or any other entity related to providing, obtaining, and/or securing the quote” (O’Malley; paragraph [0028]) to teach a form of the customer first response comprising a message to a manufacturer; and Examiner interprets Quido’s teachings of “[o]nce a quote has been processed and a premium has been generated, the customer would be able to modify any quote information ... [...] ... during the quoting process rather than in the binding process” to teach a form of “adjusting the budgetary quote;” (Quido; paragraph [0042]), and Quido’s teachings of “the user may activate a submit button to receive an estimated quote. The quote is generated as a non-binding offer ... [...] ... If the quote is believed satisfactory, and the user wishes to purchase a policy, the applicant is invited to activ[ate] a purchase button to continue the process and thereby to enter into the binding procedure” (Quido; paragraph [0018]) to teach a form of receiving a customer second response comprising a request for a contractual quote.

As per Applicant's arguments in pages 12-24 of the 3 April 2007 response that the combined applied references fail to teach the newly added limitations to claims 1, 8, 9, 16, 17,

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and 24, Examiner respectfully disagrees, and notes that these limitations have been discussed earlier in this Office Action.

At page 25, paragraph 3 of the 3 April 2007 response, Applicant apparently argues that there is no suggestion to combine the references. In response to Applicant's argument, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5

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USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Moreover, Applicant apparently ignores the evidence given by the Examiner, namely, recitations of specific portions of the applied reference, express articulation of the combinations

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and the motivations for combinations, as well as the scientific and logical reasoning of one skilled in the art at the time of the invention, as given in the prior Office Action (see paper number 20070207). Note, for example, the motivations explicitly stated at lines 5-7 of page 4 of the previous Office Action (i.e., " ... with the motivations of providing a means to "significantly reduce the time required to ..."), and at lines 5-9, page 6 of the prior Office Action (i.e., " ... with the motivations of providing "a system and method for executing transactions that streamlines ... ") and at page 9, lines 13-14 in the prior Office Action (i.e., " ... with the motivations of providing "a web site that reduces ... ").

As such, it is respectfully submitted that Applicant appears to view the applied references separately, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Consequently, it is respectfully submitted that contrary to Applicant's allegations, the features that Applicant disputes are clearly within the teachings of the applied references and that Applicant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

In response to Applicant's assertions on page 25, paragraph 1, of the 3 April 2007 response, that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Kennedy et al., U.S. Patent Number 6963847, Medina et al., U.S. Patent Application Publication Number 2002/0116210, Kumar et al., U.S. Patent Application Publication Number 2002/0042756, Shavit et al., U.S. Patent Number 4799156, Freedman et al., U.S. Patent Application Publication Number 2002/0002475, Vega, U.S. Patent Application Publication Number 2002/0120554, and Lukis et al., U.S. Patent Number 6701200 teach the environment of network based quotes for products and services.

11. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark
"EXPEDITED PROCEDURE".

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For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

July 18, 2007


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER